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10/500,415	06/24/2004	Alexandre Bouriant	2002P16249WOUS	2074

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Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

DEGA, MURALI K

ART UNIT	PAPER NUMBER
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3621

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09/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,415	Applicant(s) BOURIANT ET AL.	
	Examiner Murali K. Dega	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-67 is/are pending in the application.
- 4a) Of the above claim(s) 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50 and 52-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This Office action is in response to the amendments and remarks files by the Applicant on 30 April 2009.
2. Claims 50, 53-67 are pending
3. Claims 50, 53-67 have been examined.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 50, 51-67 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. Claim 50 recites "A system" and describes "an integration platform", "an adaptor base" as well as different "mechanisms", which indicate computer programs only.

"Computer programs claimed as separately testable units or elements *per se*, i.e., the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed."

MPEP §2106.01 I. Because the claims recite only abstractions that are neither "things" nor "acts," the claims are not within one of the four statutory classes of invention. The Examiner notes that using the broadest reasonable interpretation of "A system", "an integration platform", "an adaptor base" and "mechanisms", the claim is interpreted as

software only. Because the broadest reasonable interpretation of “an integration platform”, “an adaptor base” and “mechanisms”, includes software *per se*, the claim is not within of the four statutory classes of invention and are therefore rejected under 35 U.S.C. § 101.

7. Claims 52-67 are also rejected as they depend from independent claim 50.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 50, 53 and 54 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 50 recites “automated production process” in line 6 of page 2. It is unclear to one of ordinary skill in the art, as to what “automated production process” is and the basis to decide in the alternative, what if it is not an “automated production process”.

11. Claim 50 recites “a control solution” in line 9 of page 2. It is unclear to one of ordinary skill in the art, as to what “a control solution” is. The term is not sufficiently precise to provide competitors with an accurate determination of the meets and bounds of protection involved (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

12. Claim 50 recites “the integration platform comprises an adaptor base” in line 7 of page 2. However, claim 53 recites “the first mechanism is adapted for detecting the use

of the adaptor base or the integration platform". It is unclear to one of ordinary skill in the art if the adaptor base and the integration platform are mutually exclusive or as claim 50 recites adaptor base is part of the integration platform.

Claim 54 recites "detecting the expansion of the functionality of the software product or the integration platform. It is not clear if the phrase applies to integration platform also or just to the software product, Indicating that the first mechanism is only used for detecting the integration platform.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 50, 52-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biddle et al. (2002/0107809) in view of Schneck et al. (US 2003/0172034) and further in view of Eng (US 2002/0169725).

15. With respect to claim 50:

16. Biddle discloses a system for the graduated ("subscription-based model", Abstract), usage-equivalent licensing ("*a usage-based model*", ¶ [0102]) of multifunctional and/or expandable software products ("multi-threaded application", Claim 15), comprising:

a. an integration platform (*"Integrating", ¶ [0014]*) to integrate selected ones of a plurality of software products (*"integrating licensing management as part of the installation process", ¶ [0014]*) purveyed by a licensor to a systems integrator through the system, the integration platform being arranged by the systems integrator (*"optionally customize the implementation of the licensing management system", ¶ [0014]*) to control an automated production (*"manufacturing", ¶ [0134]*) process, wherein the integration platform (*"functionality to integrate", ¶ [0077]*) comprises an adaptor base (*"an install program", ¶ [0054]*), wherein the adaptor base is adaptable by the systems integrator to create respective application-specific adaptors (*"the vendor/developer generates optionally customized instructions for wrapping license management code around the application to create a license management protected application", ¶ [0015]*), wherein a control solution provided by the systems integrator to an end user of the automated production process comprises at least one of the following: a first group of software products (*"function of distributing software products", ¶ [0053]*) as integrated by the systems integrator in the integration platform without application-specific adaptors (*"an install program", ¶ [0054]*), and a second group of software products as integrated by the systems integrator and further including application-specific adaptors, wherein the control solution is purveyed by the systems integrator to the end user through said system, wherein the control solution can be expanded by the systems integrator to include additional software products (*"adding or removing product levels and options", ¶ [0071]*)

and/or application-specific adaptors based on new functionality (*"customize the functionality", Claims 35 and 36*) provided by the additional software products and/or application-specific adaptors;

b. Biddle discloses various modules designed to facilitate different software products work together (*"customize the functionality", ¶ [0058]*) but does not explicitly disclose each module as a mechanism to perform a certain function.

c. However, Schneck teaches a first mechanism for detecting functionality used and for comparing (*"If the current data element is determined not to be in the body of the data (step S408), the distributor then determines if the current data element is access rules provided by the data owner", ¶ [0108]*) this with already licensed functionality of a software product.

d. a second mechanism for providing information regarding functionality used but not yet licensed (*"If the current data element (being processed) is not access rules, the distributor determines whether or not it is ancillary information (step S424). This information includes such things as the identification of the publisher and the like", ¶ [0109]*).

e. a third mechanism for generating time-limited authorization to use functionality not yet licensed (*"output permission list in the rules would specify "n copies, only valid for 15 minutes from x to x+15", ¶ [0261]*).

f. fourth mechanism for generating an order and/or a request for an offer to a licensor (*"At each point where the developer requires authorization, the executable software requests a permission-check", ¶ [0291]*).

- g. a fifth mechanism for creating a license by the licensor (*"If the requisite authorization is received, the function of the software is performed", ¶ [0291]*).
 - h. a sixth mechanism for permanently-authorizing use of the functionality licensed by the system (*"The certificate is issued by an authorized Certification Authority", ¶ [0184]*) wherein a license fee is based on the following: a volume of data managed by the integration platform in connection with the automated production process, the software products integrated in the integration platform and. a number of application-specific adaptors used for Providing the control solution to the automated production process.
 - i. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to have combined the system of wrapping licensing instructions around a software product and integrating licensing management as part of the installation process of Biddle with Schneck's system of protecting and controlling of data as well as determining and protecting rules that govern access to that data, for the purpose of improved distribution of software applications where the initial cash outlay will be reduced benefiting the buyer of the application, with neither undue experimentation nor risk of unexpected results.
17. With respect to claim 52:
18. Schneck discloses wherein the first mechanism is adapted for detecting a new instance (*"If this is the first time the access mechanism is processing rules for this data set... determined whether these are the first rules being processed for this data set" ¶ [0119]*) of the software product or the integration platform.

19. With respect to claim 53:

20. Schneck discloses wherein the first mechanism is adapted for detecting the use of the adapter base (*"the data are being accessed by an application via an insecure operating system (OS) which invokes the access mechanism 114", ¶ [0146]*) or the integration platform (The standard operating system being the standard framework).

21. With respect to claim 54:

22. Schneck discloses wherein the first mechanism is adapted for detecting the expansion (*"If the current data element is determined not to be in the body of the data (step S408), the distributor then determines if the current data element is access rules provided by the data owner", ¶ [0108]*) of the functionality of the software product or the integration platform

23. With respect to claim 55:

24. Schneck discloses wherein the second mechanism is adapted for informing a user by a dialog window about functionality used by said user but not yet licensed and to request said user to obtain a license for the functionality used (*"If the current data element (being processed) is not access rules, the distributor determines whether or not it is ancillary information (step S424). This information includes such things as the identification of the publisher and the like", ¶ [0109]*).

25. With respect to claim 56:

26. Schneck discloses wherein the third mechanism is adapted for issuing a provisional license for a period of time needed for handling the order and for generating

and installing a permanently valid license (*"output permission list in the rules would specify "n copies, only valid for 15 minutes from x to x+15", ¶ [0261])*).

27. With respect to claim 57:

28. Schneck discloses wherein the fourth mechanism is adapted for e-mailing the licensor an order for the granting of a license (*"A software program (or electronic mail message) may request that a receipt be issued whenever it is loaded or executed", ¶ [0315])*).

29. With respect to claim 58:

30. Schneck discloses wherein a customer-specific account has been provided for automatically debiting (*"Others employ a prepaid balance which is debited", ¶ [0190])* the license fee due following receipt of an e-mailed order.

31. With respect to claim 59:

32. Schneck discloses wherein a card on which a pre-paid amount is registered is provided as the customer account (*"uses virtual credit cards to provide secure transactions from the Web", ¶ [0189])*.

33. With respect to claim 60:

34. Schneck discloses wherein the fourth mechanism (*"invention controls secondary distribution and creation of derivative works", ¶ [0043]* and *"secondary distribution or distribution of modifications (derivatives) of data or information is passive. However, the invention's control of executable software capability is active and requires that the executable software developer use the programming interface provided by the system. At each point where the developer requires authorization, the executable software*

requests a permission-check", ¶ [0291]) is adapted for e-mailing the licensor a request for an offer to grant a license.

35. With respect to claim 61:

36. Schneck discloses wherein the fifth mechanism is adapted for granting a license for producing a license key ("*Controlling Secondary Distribution*", ¶¶ [0248]-[0251] and "*Transmission of (an unencrypted copy of) a derivative work (to a network, to an output device such as a tape or disk, or to a printer or display device or the like) can only be effected when the system, acting under the rules embodied in permission lists created by each of the owners of any intellectual properties used in the derivative work, allows external output*", ¶ [0265]).

37. With respect to claim 62:

38. Schneck discloses issuing a provisional license for a period of time needed but does not explicitly disclose disabling the new functionality after a specified period of time. However, Eng teaches wherein a seventh mechanism is adapted for disabling ("*a license lockout can be performed upon the expiration of a grace period*", Abstract and "*steps of measuring a license grace period and initiating a license lockout if the grace period is exhausted*", ¶ [0012]) the newly used functionality if licensing is not carried out by the licensor within a specified period of time.

39. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to have included the system of incremental granting of access based the teachings of Schneck in addition to Eng's time based temporary granting of permissions that includes disabling the access after the grace period, to ensure proper purchase of

license or permissions, which will help enforcement of license rules and improve revenues for the content authors or distributors, with neither undue experimentation nor risk of unexpected results.

40. With respect to claim 63:

41. Schneck discloses wherein the system is adapted for iterative use by a primary user (*"Controlling Use of Executable Software Control of Primary Distributions"*, ¶ [0281]) if additional functionality is provided on the basis of the software product or the integration platform by the primary user for secondary users (*"Controlling Distributions of Derivative Works"*, ¶¶ [0263]-[0268]), with-use being effected by generating secondary licenses (*"The rules associated with the parent work determine whether creation of derivative intellectual property is permitted, as well as the inheritance rules for incorporating the rules of the parent into the derivative work by the primary user"*, ¶ [0270]).

42. With respect to claim 64:

43. Schneck discloses wherein the system is adapted for provisioning a license key function for the primary user for the specifying of a licensing identity by the primary user (*"a decryption key is provided only to authorized users. The key is subsequently used to enable decryption of the information so that it is available to the authorized user(s). It is at this point that the information is subject to manipulation and redistribution without further limitation."*, ¶¶ [0015] and [0026]).

44. With respect to claim 65:

45. Schneck discloses wherein the system is adapted for a flexible scalability of the secondary licenses (*“System IDs/Public keys Other systems to which 147 these rules may be redistributed”, ¶ [0095] and “The rules associated with the parent work determine whether creation of derivative intellectual property is permitted, as well as the inheritance rules for incorporating the rules of the parent into the derivative work by the primary user”, ¶ [0270]*).

46. With respect to claim 66:

47. Schneck discloses wherein an eighth mechanism is provided for apportioning the license fees to be paid to the licensor and primary user by the secondary user (*“License fees and restrictions imposed by the owner of a work are inherited by any derivative works”, ¶ [0265]*).

48. With respect to claim 67:

49. Schneck discloses wherein apportioning of the license fees (*“Some electronic payment systems operate in real time by communicating through the Internet”, ¶ [0190]*) is provided via web licensing service.

Claim Interpretation

50. Because claims 50-67 recites neither "step for" nor "means for," claims 50-67 fails Prong (A) as set forth in MPEP §2181. Because claim 50-67 fails Prong (A) as set forth in MPEP §2181, the Examiner concludes that claim 50-67 does not invoke 35 U.S.C. §112, 6th Paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

51. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

j. **Application:** "A program designed to assist in the performance of a specific task, such as word processing, accounting, or inventory management. Compare utility." Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

k. **can:** "1...f : be inherently able or designed to." Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

l. **To:** "2a -- used as a function word to indicate purpose, intention, tendency, result, or end." Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

m. **For:** "1 a -- used as a function word to indicate purpose... b -- used as a function word to indicate an intended goal" Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

n. **Mechanism:** "2. the means by which an effect is produced or a purpose is accomplished." The Random House College Dictionary. Revised Edition 1982.

o. **System:** “(n) system (a procedure or process for obtaining an objective)”, “they had to devise a system that did not depend on cooperation”. WordNet: An Electronic Lexical Database, May 1998. ISBN-10: 0-262-06197-X and ISBN-13: 978-0-262-06197-1

p. **Adapt:** “to make fit (as for a specific or new use or situation) often by modification.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A. 1986.

Response to Arguments

2. Rejection of claim 67 under 35 U.S.C § 112 Second paragraph, is withdrawn in light of the amendments made by the Applicants.

3. Applicant's arguments with respect to claim 50 have been considered but are moot in view of the new ground(s) of rejection.

4. In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious.

Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” In this case, the combination of access control to data as disclosed by Biddle and Schneck and software license allocation as disclosed by Eng would yield a predictable result, specifically: Plurality of software or digital content and hardware platforms. It would have been obvious to one

of ordinary skill in the art to modify Biddle, Schneck to include Eng because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

6. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Murali K. Dega whose telephone number is (571)270-5394. The examiner can normally be reached on Monday to Thursday 7.30 to 4.00 ET.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571)272-6779. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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